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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,981	07/03/2003	Louis Brown Abrams	4811-14	4355
22442 7590 12/27/2006 SHERIDAN ROSS PC 1560 BROADWAY SUITE 1200 DENVER, CO 80202			EXAMINER JUSKA, CHERYL ANN	
			ART UNIT	PAPER NUMBER
			1771	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		12/27/2006	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/613,981

Applicant(s)

ABRAMS, LOUIS BROWN

Examiner

Cheryl Juska

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18, 23-28 and 35-44 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-18, 23-28 and 35-44 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10/17/06.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed October 17, 2006, has been entered. Claims 1, 11, 23, 27, 28, and 35 have been amended as requested. Claims 19-22 and 29-34 have been cancelled.

Thus, the pending claims are 1-18, 23-28, and 35-44.

2. Said amendment is sufficient to withdraw the 112, 1st and 2nd rejections of claims 35-44 as set forth in sections 7-11 of the last Office Action. Said amendment is also sufficient to withdraw the 102/103 rejection of claims 23-26 and 28 as set forth in section 17 of the last Office Action. Specifically, the subject matter of previous claim 27 has been added to claim 23. Since claim 27 was not rejected under 102/103, said rejection is hereby withdrawn.

Priority

3. It is noted that the first line of the specification has not been amended to reflect the proper priority documents as set forth in section 6 of the last Office Action.

Double Patenting

4. Applicant is advised that should claim 11 be found allowable, claim 17 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 23-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Independent claim 23 has been amended to limit the first adhesive layer to being distributed substantially “evenly” while the second adhesive layer is distributed substantially “unevenly.” The specification as originally filed does not provide support for the descriptions of “evenly” and “unevenly.” While the specification does teach “continuous” and “discontinuous” adhesive layers, it is noted that the scope of “evenly” and “unevenly” is not commensurate with “continuous” and “discontinuous.” Specifically, a “continuous” adhesive layer with a varying thickness can be described as an “unevenly” distributed adhesive layer. Therefore, claims 23-28 are rejected as containing new matter.

7. Claims 35-44 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Independent claim 35 has been amended to limit the second adhesive layer to being a “web adhesive” while the first adhesive layer is “not a web adhesive.” The specification as originally

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filed does not provide support for the descriptions of “not a web adhesive.” The scope of what is a “web adhesive” and what is “not a web adhesive” is not clearly set forth in the specification. MPEP 2173.05(i), *Negative Limitations*, states “Any negative limitation or exclusionary proviso must have basis in the original disclosure.” See *Ex parte Grasselli*, 231 USPQ 393. The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Therefore, claims 35-44 are rejected as containing new matter.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 3-18, and 23-28 are rejected under 35 USC 102(a) as being unpatentable over JP 2001-270019 assigned to Shingii alone or in view of US 3,961,116 issued to Klein.

Shingii discloses flocked fibers adhered either one or both sides of a stretchable, flexible, and elastic sheet (abstract). Said elastic sheet is preferably a waterproof, foamable chloroprene rubber (abstract). The flock is adhered via an adhesive layer (abstract and Figure 1). Hence, in the embodiment wherein flock is applied to both sides of the elastic sheet, a second adhesive is applied (translation, section [0019] and Figure 5). Note applicant's claims do not exclude another material being bonded to said second adhesive.

Therefore, Shingii teaches the limitations of claim 1 with the exception of the discontinuous second adhesive layer. While Shingii teaches continuous adhesive layers for application of the flocked fibers, it is well known in the art of flocking to employ discontinuous adhesive layers. Specifically, it is known to apply a discontinuous adhesive layer in order to improve the flexibility of a flocked substrate as compared to a continuous adhesive layer. Applicant is hereby given Official Notice of this fact. Thus, it would have been readily obvious to one of ordinary skill in the art to modify the Shingii reference with at least one discontinuous layer of adhesive in order to improve the flexibility of the flocked substrate. Therefore, claims 1, 6, 8, 10, 12, and 14 are rejected as being obvious over the cited Shingii reference alone.

[Note said Official Notice was given in section 15 of the last Office Action. To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. (“[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention.”). A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate. Since applicant failed to adequately traverse said Official Notice in the response to the last Office Action, the facts asserted to be common knowledge or well-known in the art are taken to be admitted prior art. See MPEP 2144.03.]

Alternately, it is well known to apply said adhesive discontinuously in order to provide air and moisture permeability (Klein, col. 2, lines 24-27). Thus, it would have been readily obvious to one of ordinary skill in the art to apply the adhesive layer or layers of Shingii in a

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discontinuous manner in order to provide breathability to the substrate. Therefore, claims 1, 6, 8, 10, 12, and 14 are rejected as being obvious over the cited Shingii reference in view of the Klein reference.

Regarding claims 3-5 and 23-26, the Shingii reference fails to teach the claimed properties of modulus, elongation, and recovery of the elastic sheet. However, it is argued that the cited elastic properties are present in the prior art or would be readily obvious over the cited art since Shingii teaches an elastic base sheet that meets the chemical and structural limitations of the claims. Like materials cannot have mutually exclusive properties. The burden is upon applicant to prove otherwise. Thus, said claims are rejected as being obvious over the cited Shingii reference alone or in view of the cited Klein reference.

With respect to claim 7, while the prior art fails to teach the elastic sheet is a thermoplastic polyurethane, it would have been readily obvious to one of ordinary skill in the art to select said polyurethane. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. *In re Leshin*, 125 USPQ 416. Hence, claim 7 is also rejected.

With respect to claims 11, 16-18, 27, 28, 35, and 39-42, said claims are rejected along with claim 1 in that the limitations that the second adhesive layer is a “web” adhesive or made of sets of filaments are not seen to further distinguish the present invention from the prior art. Specifically, the web of filaments is descriptive of the form of the adhesive before activation. In other words, said web is an intermediate product and not necessarily present in the final product as claimed. Therefore, said claims are also rejected.

Regarding claims 9, 13, 15, 43, and 44, the prior art fails to teach the claimed thicknesses.

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However, said thicknesses are held to be obvious over the prior art. Specifically, it would have been obvious to one skilled in the art to employ the thicknesses in the amounts recited by applicant, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. Therefore, claims 9, 13, 15, 43, and 44 are also rejected.

Claims 36-38 are rejected along with claim 35 since said claims amount to method limitations in a product claim. As such, the limitations to the order and timing of the process steps are not given patentable weight at this time. In order to be given patentable weight, a method limitation must materially effect the final product in a structural manner.

The presence of process limitations on product claims in which the product does not otherwise patentably distinguish over the prior art, cannot impart patentability to the product. *In re Stephens*, 145 USPQ 656. It is asserted that the claimed order and timing of the process steps do not materially effect the product produced as compared to the prior art product. Therefore, claims 36-38 are also rejected.

10. Claim 2 is rejected under 35 USC 103(a) as being unpatentable over the cited Shingii reference alone or in view of Klein as applied to claim 1 above and in further view of US 5,597,637 issued to Abrams.

Shingii and Klein fail to teach application of the flock via a flock transfer. However, said flock transfers are well known in the art. For example, Abrams teaches an elastomeric flock transfer for applying flock to a stretchable substrate (abstract). thus, it would have been readily obvious to one of ordinary skill in the art apply the flock to the elastic base sheet via a flock

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transfer in order to provide a decorative flock pattern or in order to provide the pre-formed flock transfer. Therefore, claim 2 is rejected.

Response to Arguments

11. Applicant's arguments filed with the amendment have been fully considered but they are not persuasive.

12. Applicant traverses the rejection of the claims over Shingii in view of Klein by arguing that the teachings of the references contradict each other (Amendment, page 11, 2nd paragraph). Specifically, applicant states, "Shingii teaches that such continuously applied layers are desirable for providing elastic properties, which is contrary to the Examiner's stated motivation to modify Shingii to realize the present invention." (Amendment, page 11, 2nd paragraph). The examiner respectfully disagrees with applicants statement of Shingii's teaching. Notably, the reference fails to teach or even suggest that the adhesive layer needs to be continuous in order to provide elastic properties. Therefore, applicant's argument is found unpersuasive.

13. Applicant also argues, "'Web' adhesives have a clear meaning to one of ordinary skill in the art of adhesive formulations." (Amendment, page 11, 3rd paragraph). However, applicant fails to explain what said "clear meaning" is. For the purposes of examination, the term "web" is defined as stated in the class definition for US Classification Schedules and Definitions, Class 428, *Stock Materials or Miscellaneous Articles*:

A portion of material having length and width each greater than its thickness and with at least its longitudinal dimension indeterminate.

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Thus, the phrase “web” adhesive reads on any adhesive film or sheet or layer having a length and width greater than its thickness and having an indeterminate longitudinal dimension. Hence, Shingii actually teaches “web” adhesives.

14. Applicant also asserts, “It is well known that an intermediate product can be claimed.” (Amendment, page 11, 3rd paragraph.) In response, said assertion is true, in part. An intermediate product can be recited in claim to a final product. However, for said intermediate product to be given patentable weight, the intermediate must materially effect the structure of the final product. An adhesive layer made of sets of filaments is no longer recognizable as such in the final product, but rather, said adhesive layer is merely characterized as being discontinuous. When the prior art’s intermediate product can produce the same final structure of a discontinuous layer, then the recitation to said intermediate structure is not given patentable weight. Therefore, applicant’s argument is found unpersuasive and the above rejection stands.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

16. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached at 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


CHERYL A. JUSKA
PRIMARY EXAMINER